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10/669,653

09/25/2003

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EXAMINER

SMITH, JEFFREY S

ART UNIT

PAPER NUMBER

2624

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/669,653

Applicant(s)

NAKAMURA ET AL.

Examiner

Jeffrey S. Smith

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/ are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Specification

The amendment filed 1/14/2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is found in claims 6, 10 and 11 as discussed in the rejection under 35 U.S.C. 112, first paragraph, below.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 6, 10 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 6 and 10 recite "transmits the corrected image and image data simultaneously to the image recording section" which is missing from the application as originally filed.

Claim 11 recites "transmits the corrected image and image data sequentially to the image recording section" which is missing from the application as originally filed.

Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the phrase "records at least either one of a set of image and information capable of reproducing the original image and the original image a second external media for recording an image in form of at least either one of an image recording on a visual basis and a recording by image data" does not make any sense. For example, what is "a set of image?" What is "information capable of reproducing the original image and the original image?" What is "a set of image and information?" Claim 4 has the same problem.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Number 7,035,462 issued to White et al. ("White").

For claim 1, White discloses an image data input section that enters image data representative of an original image (scanner 64 in figure 10); an image correcting section that applies a predetermined correcting processing to the original image represented by the image data entered through the image data input section to create corrected image (red-eye correction algorithm shown in figure 11); and an image recording section that records the corrected image subjected to the correcting processing in the image correcting section onto a first external media for recording an image in form of at least either one of an image recording on a visual basis and a recording by image data (output image from printer 61 of figure 10), and records at least either one of a set of image and information capable of reproducing the original image and the original image a second external media for recording an image in form of at least either one of an image recording on a visual basis and a recording by image data (column 14, the pixel information can be the corrected pixel information and/or the pixel information previous to being corrected and stored in external media such as memory card 28 as shown in block 126 of figure 11).

For claim 2, White discloses the image correcting section applies a red-eye correcting processing to the original image (figure 11).

For claim 3, White discloses the image data input section enters a photographic image, and the image recording section records the corrected image into a

photographic print, and records the set of image and information onto a medium for recording digital data (see figure 10 and column 14).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over White.

For claim 4, White discloses the image data input section enters a photographic image, and the image recording section records the corrected image into a photographic print, and records at least either one of the set of image and information and the original image into a photographic print (see figure 10 and columns 12-13, the user can accept the corrected image for printing and can reject the corrected image to print the original image).

The Supreme Court has held that in analyzing the obviousness of combining elements, a court need not find specific teachings, but rather may consider "the background knowledge possessed by a person having ordinary skill in the art" and "the inferences and creative steps that a person of ordinary skill in the art would employ." See *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1727, 1740-41, 82 USPQ2d 1385, 1396 (2007). To be nonobvious, an improvement must be "more than the predictable use of prior art elements according to their established functions." *Id.* Here the combination is the

predictable use of printing a corrected image onto a print followed by the predictable use of printing the original image onto a print. One of ordinary skill in the art at the time of invention would expect to be able to print both the original image and the corrected image using the kiosk of White by first rejecting the red-eye correction and printing the original image onto a first print, then accepting the red-eye correction and printing the corrected image onto a second print as taught by White in figures 10-11 and columns 12-14 to achieve the predictable result of printing the original and corrected images.

Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over White in view of U.S. Patent Number 6,345,998 issued to Shiota et al. ("Shiota").

For claim 5, White discloses the elements of claim 1. Shiota discloses that the image correcting section transmits the corrected image and image data together to the image recording section (the image recording section 193 as shown in figure 3 does not actually record any images, but rather forwards the data from correcting section 192 to actual recording devices such as an electronic memory 165 or paper 30 as shown in figure 5. The disclosure is silent as to whether the substrate 190 is implemented as hardware circuitry, software executed by a processor, or a combination of hardware and software. Given the fact that the disclosure is silent as to the specific implementation of the substrate 190, and given the fact that there is no patentable distinction between a hardware substrate and a substrate implemented as software running on a computer, and given the fact that paragraph 66 of the specification defines the image recording section in the functional terms of something that transmits corrected image data and

original image data to external media, the computer 15 of Shiota as shown in figure 8 has an image correcting section that transmits the corrected image and image data together to an image recording section, or output port, of computer 15, which then transmits the corrected image and image data to external media 5 and 6.

It would have been obvious to a person of ordinary skill in the art at the time of invention to transmit the corrected image and image data together to an output port for the benefit of increasing efficiency as taught by Shiota in col. 1 line 65-col. 2 line 13.

For claim 6, the combination of White and Shiota disclose that the image correcting section transmits the corrected image and image data simultaneously to the image recording section as discussed in the rejection of claim 5.

For claim 7, the image recording section records one of the corrected image or the original image as image recording on a visual basis onto a printing medium and if said corrected image is printed, the original image data is output to the second external medium as electronic data can be predictably achieved by printing the red eye corrected image of White using the printer 5 shown in Figure 1 of Shiota and by storing the original red eye image of White in electronic form using the disk 6 of Figure 1 of Shiota.

For claim 8, the image recording section records one of the corrected image or the original image as image recording on a visual basis onto a printing medium and if the original image is printed, the corrected image data is output to the second external

medium as electronic data can be predictably achieved by printing the original image that has red eye from White using the printer 5 of Shiota and electronically storing the red eye corrected image of White using the disk 6 of Shiota.

Claims 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota in view of White.

For claim 9, Shiota discloses an image data input section that enters original image data representative of an original image (the scanner shown in figure 1 and discussed in col. 8 lines 1-14).

an image processing section that applies a predetermined processing to the original image data to create processed image data, and transmits the original and processed image data to the image recording section (see for example fig 1 which shows image processing means and fig. 8 which shows image data received by image recording section output port of computer 15).

an image recording means for recording one of a first processed image data subjected to the correcting processing and the first processed image data onto a first external media for recording one of an image perceived on a visual basis and a recording of corrected image as electronic data (see figure 1 printer 5), said image recording means for further recording one of the image data capable of reproducing the original image and the original image onto a second external media for recording one of an image perceived on a visual basis and a recording of the original image data as electronic data (see figure 1 disk 6).

Shiota does not explicitly disclose an image red eye correcting section that applies a red eye correction processing to the original image data to create red eye corrected image data.

White discloses the image processing section that is a red eye correcting process as discussed in the abstract. White also discloses the image processing section generates image metadata capable of reproducing the original image as discussed in col. 14. It would have been obvious to a person of ordinary skill in the art at the time of invention to use the red eye correction image processing of White in the image processing means 3b of Shiota and to use the metadata image processing that generates image data capable of reproducing the original image of White in the image processing means 3a of Shiota to achieve the predictable result of printing the red eye corrected image and storing the original image data electronically.

For claim 10, the combination of White and Shiota disclose the image correcting section transmits the corrected image and image data simultaneously to the image recording section because the image recording section is the output port of a computer system such as that shown in figure 8 of Shiota.

For claim 11, the combination of White and Shiota disclose the image correcting section transmits the corrected image and image data sequentially to the image recording section because the image recording section is the output port of a computer system such as that shown in figure 8 of Shiota.

For claim 12, the image recording section records one of the corrected image or the original image as image recording on a visual basis onto a printing medium and if said corrected image is printed, the original image data is output to the second external medium as electronic data can be predictably achieved by printing the red eye corrected image of White using the printer 5 shown in Figure 1 of Shiota and by storing the original red eye image of White in electronic form using the disk 6 of Figure 1 of Shiota.

For claim 13, the image recording section records one of the corrected image or the original image as image recording on a visual basis onto a printing medium and if the original image is printed, the corrected image data is output to the second external medium as electronic data can be predictably achieved by printing the original image that has red eye from White using the printer 5 of Shiota and electronically storing the red eye corrected image of White using the disk 6 of Shiota.

Response to Arguments

Applicant's arguments filed January 14, 2008 have been fully considered but they are not persuasive.

Applicant argues that

The Examiner asserts that the "pixel information can be the corrected pixel information and/or the pixel information previous to being corrected" of White (col. 14, lines 13-14), as allegedly disclosing the recording of "corrected image" and "original image" to "first external media" and "a second external media" of the claimed invention. The "pixel information"

as it pertains to White, however, refers to software code. In particular, the Examiner's citation to col. 14 teaches metadata stored with the pixel data, which at best implicates storage to a single medium. The White reference does not disclose or suggest that "pixel information" is a form of second external media or is stored to a second media.

In fact, White discloses storing an uncorrected image in electronic memory such as memory card 28 and printing a red eye corrected image using printer 61.

Specifically, White discloses ... an image recording section that records the corrected image subjected to the correcting processing in the image correcting section onto a first external media for recording an image in form of at least either one of an image recording on a visual basis and a recording by image data (output image from printer 61 of figure 10), and records at least either one of a set of image and information capable of reproducing the original image and the original image a second external media for recording an image in form of at least either one of an image recording on a visual basis and a recording by image data (column 14, the pixel information can be the corrected pixel information and/or the pixel information previous to being corrected and stored in external media such as memory card 28 as shown in block 126 of figure 11).

Applicant argues that

White does not teach or suggest photographic prints of both the corrected image, and the set of image and information or the original image. Thus, White does not disclose or teach, "the image recording section records the corrected image into a first photographic print, and records at least either one of the set of image and information and the original image into a second photographic print" of the claimed invention.

In fact, White discloses printing images on paper using printer 61. Column 1 of White discusses printing the uncorrected red eye photographs, which can be achieved by White in box 218 of figure 11 by selecting no red eye correction, or by simply printing the red eye photograph without performing red eye correction. Printing the red eye corrected image can be achieved by White by performing the red eye correction process of figure 11 and printing the red eye corrected version of the image. Thus, a user who prints an image with printer 61 before using the red eye correction process, then prints an image with printer 61 after using the red eye correction process, would have the original and the red eye correction photographic prints of the image.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey S. Smith whose telephone number is 571 270-1235. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jingge Wu can be reached on 571 272-7429. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JSS
February 14, 2008

JINGGE WU
SUPERVISORY PATENT EXAMINER

